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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/544,191

03/29/2006

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EXAMINER

ZIMMERMAN, JOSHUA D

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/544,191	Applicant(s) HAYASHI, KOJI	
	Examiner Joshua D. Zimmerman	Art Unit 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/4/07</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-4 and 6-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Leenders et al. (US 5908731).

Regarding claim 1, Leenders et al. disclose “a lithographic printing plate precursor (abstract), comprising on a substrate (column 2, line 26), an oleophilic layer (column 2, line 29) containing a cross-linked product (column 2, lines 30-31), that was obtained by crosslinking a polymer having a heat decomposable group in the main chain with a cross-linking agent (column 5, lines 1-2 and column 6, lines 36-38).”

Regarding claim 2, Leenders et al. further disclose “wherein said heat decomposable group is an azo group (column 5, lines 1-2).”

Regarding claim 3, Leenders et al. further disclose “wherein said polymer, prior to crosslinking, has a functional group that is capable of reacting with a cross-linking agent (column 5, lines 1-2 and column 6, lines 36-38).”

Regarding claim 4, Leenders et al. further disclose “wherein said substrate has a hydrophilic surface (column 2, line 26).”

Regarding claim 6, Leenders et al. further disclose “further comprising a hydrophilic layer between said substrate and said oleophilic layer (column 7, lines 66-67).”

Regarding claim 7, Leenders et al. further disclose "wherein said hydrophilic layer contains a photo-to-heat converting material (column 8, lines 11-12)."

Regarding claim 8, Leenders et al. teach "a method for preparing a lithographic printing plate (example 1) comprising:

exposing the lithographic printing plate precursor of claim 1, to IR radiation and removing the exposed part of said oleophilic layer (column 9, lines 30-39)."

Regarding claim 9, Leenders et al. further teach "mounting the exposed lithographic printing plate precursor directly on a printer without developing (column 9, lines 37-43, column 8, lines 51-57. Examiner points out here that the rubbing step of Leenders et al. is not a development step, but rather a 'cleaning' step)."

Regarding claim 10, Leenders et al. further teach "wherein said heat decomposable group is an azo, diazo, dioxy, disulfide, hydrazide, nitro, onium salt, sulfonic ester, disulfonyl, or thiosulfonic group (column 5, lines 1-17)."

Regarding claim 11, Leenders et al. further teach "wherein said polymer having a heat decomposable group is used in combination with another thermally decomposable compound (column 5, lines 59-63 or column 6, lines 50-52. Examiner also notes that any of the other compounds used by Leenders et al. are thermally decomposable, as all organic compounds are thermally decomposable)."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leenders et al. in view of Maemoto et al. (US 2003/0148207).

Regarding claim 5, Leenders et al. teach all that is claimed, as applied in claim 1 above, but fail to teach that "said oleophilic layer further contains a photo-to-heat converting material." However, Leenders et al. teach the incorporation of titanium dioxide particles in order to strengthen the mechanical properties of the layer (column 8, lines 1-2 and 1-12). Maemoto et al. teach the same, but on the oleophilic image layer (paragraphs 247 and 248). Therefore, at the time of the invention, it would have been obvious to one having ordinary skill in the art to incorporate the particles into the oleophilic layer of Leenders et al. in order to strengthen the mechanical properties of the layer.

Response to Arguments

Applicant's arguments filed 4/4/07 have been fully considered but they are not persuasive.

3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the crosslinked polymer has heat decomposable groups and that the heat decomposable groups participate in imaging) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As presently claimed, the printing plate precursor requires only an oleophilic layer containing a crosslinked product that was obtained by crosslinking a polymer having a heat decomposable group with a crosslinking agent. As outlined above (and admitted by applicant in the second full paragraph of page 6 of applicant's remarks filed 4/04/2007), the precursor of Leenders et al. anticipates this limitation since the precursor of Leenders et al. contains a hydrophobic layer which is obtained by crosslinking a compound with a heat-decomposable group with a crosslinking agent (column 5, lines 1-2).

4. In response to applicant's argument that Maemoto et al. or Leenders et al. use titanium dioxide particles for a different reason than applicant, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Further, applicant seems to have interpreted the combination of Maemoto et al. and Leenders et al. as replacing the oleophilic layer composition of Leenders et al. with that of Maemoto et al. This is incorrect. As reiterated in the rejection above, both Maemoto et al. and Leenders et al. teach incorporating titanium dioxide particles in a polymer layer in order to increase the mechanical strength of the polymer layer, and it is

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this teaching that is used as motivation to incorporate the particles into the hydrophobic layer of Leenders et al.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Zimmerman whose telephone number is 571-272-2749. The examiner can normally be reached on M-R 8:30A - 6:00P, Alternate Fridays 8:30A-5:00P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua D Zimmerman
Examiner
Art Unit 2854

jdz


JUDY NGUYEN
SUPERVISORY PATENT EXAMINER